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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/653,193
Filing Date: September 03, 2003
Appellant(s): MAEKAWA, MASAMI

Lee Cheng, Reg. No. 40,949
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/8/11 appealing from the Office action

mailed 6/8/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying

by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-20 are pending and rejected.

Claim 21 is pending but has been withdrawn from consideration as being drawn

to a non-elected invention.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of

amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter

contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of

rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being

maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are

provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in

the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,923,018 A	**KAMEDA et al.**	**07-1999**
2004/0019501	**WHITE et al.**	**01-2004**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kameda et al (US 5,923,018--hereinafter Kameda) in view of White et al (US

2004/0019501 A1)

[claim 1]   Kameda discloses an examination scheduling program, stored in computer memory and having computer executable instructions for causing a computer to create a schedule for each patient, said program causing said computer to perform:

- function for fetching information on contents of the examination for each patient and an order of examination for each patient; and (col. 10, lines 40-60; col. 17, lines 54-col. 18, line 31)

- a function for fetching a waiting time from the medication to the examination set according to a type of examination; (Figure 2; col. 10, lines 1-49; Figure 7; col. 17, lines 54-col. 18, line 31—time increments between medication and testing/process are displayed)

- a function for generating (i.e. displaying) an examination schedule of patients (Figures 4-5; col. 4, lines 45-56; See also: col. 9, lines 12-52; col.11, lines 4-20; 36-56)

Kameda discloses the program as described above, but does not expressly disclose a function for creating an examination schedule based upon contents of the examination for each patient and an order of examination for each patient, and waiting time.

White discloses a system and application for generating/creating an examination schedule and patient queues and tracking based upon retrieved patient data, patient order, and waiting time required for given procedures (Figs. 2B, 7B, 8B, 9A-B; par. 38-41, 44-45, 49, 54-55).   At the time of the Applicant's invention, it would have been

obvious to one of ordinary skill in the art to combine the system of Kameda of with the

teaching of White to create an examination schedule based on information on contents

of the examination, an order of examination and the waiting time. As suggested by

White, one would have been motivated to include this feature to permit the staff

members to define the steps in the medical testing process, to track the flow of patients

from step to step in the medical testing process, to record the completion of steps as to

individual patients, and to organize priorities for staff members carrying out each step.

(par. 29)

Also, it should be noted that the recitation of " to avoid overlapping in time

between timing of the medication and examination for each patient" is intended use. A

recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim.

It is noted that the claim has been amended to recite "a single nuclear medical

examination." However, the recitation of "a single nuclear medical examination" has not

been given patentable weight because the recitation occurs in the preamble. A

preamble is generally not accorded any patentable weight where it merely recites the

purpose of a process or the intended use of a structure, and where the body of the

claim does not depend on the preamble for completeness but, instead, the process

steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481

(CCPA 1951).

[claim 2]   Kameda discloses an examination scheduling program as defined in claim

1, wherein said schedule for each patient is expressed by a pattern having a time span

according to the type of examination, said pattern presenting the timing of the

medication, the waiting time and the contents of the examination. (Figure 8; col. 18,

lines 9-31; See also col. 9, lines 12-53, col. 11, lines 4-20)

[claim 3] Kameda discloses the examination scheduling program as defined in claim 1,

wherein said schedule for each patient is displayed in form of a pattern on a time chart,

with a line representing present time displayed to move on the time chart with progress

of time. (Figures 5-7)

[claim 4] Kameda discloses the examination scheduling program as defined in claim 2,

wherein said schedule for each patient is displayed in form of a pattern on a time chart,

with a line representing present time displayed to move on the time chart with progress

of time. (Figures 4, 9)

[claim 5] Kameda discloses the examination scheduling program as defined in claim 1,

wherein said schedule is altered by moving said pattern on said time chart with a

pointing device.

[claims 6-8] Kameda discloses the examination scheduling program as defined in claim

2, wherein said schedule is altered by moving said pattern on said time chart with a

pointing device. (col. 12, lines 56-59—various input devices include a mouse, i.e. a

point device)

[claims 9-16] Kameda discloses an examination scheduling program, wherein said

schedule for each patient is under control, and a correlation is made between actual

measurements including actual medication and examination times, and data collected

by said medical examination apparatus. (Figure 5, 6, 9; col. 17, lines 1-48; col. 18, lines

32-66)

[claims 17-20] Kameda discloses the examination scheduling program as defined in 1,

further comprising a step of inputting an actual medication time, a step of comparing a

scheduled medication time and said actual medication time, and a step of creating an

examination schedule all over again when said step of comparing shows a

disagreement. (Figure 5; col. 17, lines 1-29: result flag shows if medical action has or

has not been performed.)

   (10) Response to Argument

(A)   Appellant argues that the prior art fails to disclose "a function for creating an

examination schedule to avoid overlapping in time between timing of the medication and

the examination for each patient…" In particular Appellant argues that the prior art

functions are carried out by a user, not a computer.

   In response, the current claim language describing functions of the software

program do not preclude the description of a graphical user interface or an operator

performing the functions at a computer using the software program (i.e.

retrieving/fetching waiting time using the GUI, radio buttons or pull-down menu provided

by a software application and using this information to create the schedule). It is noted

that the claim language recites that the program is for "*causing* a computer to create a

schedule for each patient." The use of a software program on a computer (by an

operator) causes a computer to generate a schedule.

The prior art addresses the claimed limitations. Kameda discloses a computer

program with a function for generating (i.e. displaying) an examination schedule of

patients (Figures 4-5;col. 9, lines 12-52; col.11, lines 4-20; 36-56). Kameda displays

schedules for patients' medications, medical examinations, and medical care, but does

not expressly disclose a function for creating an examination schedule based upon

contents of the examination for each patient and an order of examination for each

patient, and waiting time.

White discloses a system and application for generating/creating a radiological

device examination schedule using patient queues and tracking based upon retrieved

patient data, patient order, and waiting time required for given procedures (Figs. 2B,

7B, 8B, 9A-B; par. 38-41, 44-45, 49, 54-55). At the time of the Applicant's invention, it

would have been obvious to one of ordinary skill in the art to combine the system of

Kameda of with the teaching of White to create an examination schedule based on

information on contents of the examination, an order of examination and the waiting

time. As suggested by White, one would have been motivated to include these features

to permit the staff members to define the steps in the medical testing process, to track

the flow of patients from step to step in the medical testing process, to record the

completion of steps as to individual patients, and to organize priorities for staff

members carrying out each step. (par. 29)

(B)   On pages 6-7 of the Appeal Brief, Appellants argue that the system does not

create the schedule automatically in the prior art.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e.," the system itself does not create the schedule") are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). As best understood by the Examiner, claim 1 is a

product claim, not a system claim.

Moreover, it should be noted that a user/operator performs the

scheduling/scheduling creation steps in the Appellant's own specification with the

assistance of the recited computer program. In other words, despite Appellant's

arguments, the Appellant's original disclosure does not support the use of a software

program performing all functions to the exclusion of a human operator.

For example, on page 15, lines 10-15, the specification describes an operator

selecting an examination schedule display to enter and edit data. The operator also

inputs/instructs examinations required for selected patients. Also, page 19, lines 1-12 of

the Appellant's specification describes the operator altering the schedule using the

computer software/interface to drag and drop changes made to the medication

timetable to avoid conflicts and overlaps.

(C)   Appellant argues that the present application is drawn toward nuclear medical

examination scheduling program, and that the present invention can avoid overlapping

of the timing of the medication required for the nuclear medical examination, a

distinction over the prior art.

In response, as explained in the prior art rejection, the Kameda patent is drawn

toward a computer program for displaying schedules of patients' medications, medical

examinations, and medical care. (Figures 4-5; col. 9, lines 12-52; col.11, lines 4-20; 36-

56). Kameda does not expressly disclose a function for creating an examination

schedule based upon contents of the examination for each patient and an order of

examination for each patient, and waiting time.

White discloses a system and computer program for generating/creating an

examination schedule for several radiological procedures on equipment using patient

queues and tracking based upon retrieved patient data, patient order, and waiting time

required for given procedures (Figs. 2B, 7B, 8B, 9A-B; par. 38-41, 44-45, 49, 54-55).

At the time of the Applicant's invention, it would have been obvious to one of ordinary

skill in the art to combine the system of Kameda of with the teaching of White to create

an examination schedule based on information on contents of the examination, an

order of examination and the waiting time. As suggested by White, one would have

been motivated to include these features to permit the staff members to define the

steps in the medical testing process, to track the flow of patients from step to step in

the medical testing process, to record the completion of steps as to individual patients,

and to organize priorities for staff members carrying out each step. (par. 29)

The recitation of "a single nuclear medical examination" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

(D)   On pages 8-12, Appellant argues that the phrase "to avoid overlapping in time between timing of the medication and the examination for each patient and timing of medication and examination for other patients" is not intended use, but a function of the computer's processing unit.

In response, it is respectfully submitted that the combined teachings Kameda in view of White do address the limitation of "creating a schedule to avoid overlapping in time between timing of the medication and the examination for each patient and timing of medication and examination for other patients." The Kameda patent is drawn toward a computer program for displaying scheduled patients' medications, medical examinations, and medical care. (Figures 4-5; col. 9, lines 12-52; col.11, lines 4-20; 36-56).   White discloses a system and computer program for generating/creating an examination schedule for several radiological procedures on equipment using patient queues and tracking based upon retrieved patient data, patient order, and waiting time required for given procedures (Figs. 2B, 7B, 8B, 9A-B; par. 38-41, 44-45, 49, 54-55).

The scheduling, patient queues and tracking of the White reference avoids overlapping among patients. White further discloses an additional prioritization function, which establishes rules regarding how the cases should be moved in a queue, and accommodates the need for expedited processing in emergency situations. (White: par. 47)

Moreover, the examiner understands the current claims (exemplary claim 1) to be a product claim (i.e. computer program product), not a system claim. Also the phrase "to avoid overlapping in time between timing of the medication and the examination for each patient…" describes a goal or an intended use of the scheduling program. On pages 10-12 the Appellant argues the functions performed by the processing unit in the instant invention. Appellant also compares structural distinctions of system(s) in the prior art to the system of the instant invention. However, the Appellant is not claiming a system and its functions.

(E)   Appellant argues that the prior art does not generate schedules in the same manner as recited in claim 2.

In response, claim 2 recites a description of data in a schedule. Kameda discloses an examination scheduling program, wherein said schedule for each patient is expressed by a pattern having a time span according to the type of examination, said pattern presenting the timing of the medication, the waiting time and the contents of the examination. (Figure 8; col. 18, lines 9-31, See also col. 9, lines 12-53, col. 11, lines 4-20)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. L. P./

Examiner, Art Unit 3626

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